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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,645	06/24/2003	Takaya Matsuishi	238486US2DIV	1282
22850	7590	11/15/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NGUYEN, MERILYN P	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,645

Applicant(s)

MATSUISHI, TAKAYA

Examiner

Marilyn P. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/20/2006</u> . | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

DETAILED ACTION

1. In response to the communication dated 10/20/2006, claims 55-69 are pending in this office action.
2. This application is a Division of 09/632,212 filed on August 03, 2000 now patent number 6,782,387.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/2006 has been entered.

Acknowledges

4. Receipt is acknowledged of the following items from the Applicant:
 - The applicant's amendment has been considered and made of record.
 - Information Disclosure Statement (IDS) filed on 20 September 2006 and made of record. The references cited on the PTOL 1449 form have been considered.

Abstract

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed

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150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. **The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.**

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. (Emphasis added).

The Examiner notes that since the amended abstract is similar to the claim, the abstract should be adjusted corresponding to the claim going to amend.

Claim Objections

6. Claims 55, 60 and 65 are objected to because of the following informalities: the claim recites second document data without first document data. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 55, 60 and 65 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 55, 60 and 65 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed on September 20, 2006. In that paper, applicant has stated, "In a non-limiting embodiment of the claimed invention, a document C is obtained from coupling documents A and B. A document name of the new document C is set to be a document name of one of the documents A or B coupled together to form document C (for example, document A). Also, original documents A and B, which become respective sections of the new

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document C, are renamed A-1, A-2..., A-n.” and this statement indicates that the invention is different from what is defined in the claim(s). For example, the claimed limitation of “a document name generating part configured to cause **a document name of the second document data obtained from coupling the plurality of document data to be a document name of one of the plurality of document data** from which the coupling is thus carried out, and to **use the document name of the second document as file names of the plurality of document data** from which the second document data is thus obtained” can be understood as document C is obtained from coupling documents A and B. The name (for example C) of document C is set to be the name (for example A) of document A and the name (C) of document C is used as file names of documents A and B. This appears as name exchanging process. The result of A coupled B = C after processing would have been C coupled C = A, which would not make any sense and would appear to be different from which applicant regard as invention.

8. Claims 56-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 55-69, the language in the claims is incomprehensible, in particular the function of the document name generating part. As present, the language describes an incoherent function, thereby rendering it difficult to follow.

Regarding claims 60-69, these claims are incomplete for omitting cooperative relationships of elements. See MPEP § 2172.01. The step of managing the plurality of

document data does not connect with the steps of controlling and causing. It's unclear how the managing function contributes to the claim invention.

Regarding claims 56, 61 and 66, there is insufficient antecedent basis for "the files" at line 3.

Regarding claims 58, 63 and 68, there is insufficient antecedent basis for "the respective files".

Regarding claims 57, 62 and 67, the claim recites, "wherein the document name generating part is further configured to use indexes indicating an order in the second document data, as the file names of the respective files from which the second document data is thus obtained" which renders the claim indefinite because it seems to be contradicted with the limitation of claim 55. Claim 55 recites the document name of the second document is used as file names of the plurality of document data while claim 57 uses indexes as the file names of the plurality document data.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 55-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (US 5,960,444), in view of Schloss (US 6,249,844).

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Regarding claims 55, 60 and 65, Jackson discloses a document data handling apparatus for coupling a plurality of document data, wherein each of the plurality of document data includes a plurality of types of files (Fig. 1), said apparatus comprising:

- a document managing part configured to manage the plurality of document data (See col. 1, lines 39-42);
- a document data coupling control part configured to control a document data coupling process in which the plurality of document data managed by the document managing part are coupled together to form second document data (see col. 3, lines 25-35); and

Jackson teaches a name generating part (See Fig. 3) to generate title information (See col. 4, lines 9-15). However, Jackson is silent as to teach generate a document name of the second document data obtained from coupling the plurality of document data. On the other hand, Schloss teaches a name creator for fragment document (See col. 7, line 29 to col. 8, line 3, Schloss et al.). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the name creator of Schloss into the system of Jackson to generate a document name of the second document data, the motivation would have been to enhance the ability of generating the document name at ease by having separate name creator software.

Jackson in incorporation with Schloss is silent as to generate a document name of the second data to be a document name of one of the plurality of document data from which the coupling is thus carried out, and to use the document name of the second document data as file names of the plurality of document data from which the second document data is thus obtained.

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However, the difference are only found in the nonfunctional descriptive material and do not alter how the name generating function (i.e., the descriptive material does not reconfigure the name generating). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to generate any name for documents, for example name of the second document and name of plurality of document data as instant invention because different names generating do not alter how the name generating functions and because the subjective interpretation of the names does not patentably distinguish the claimed invention.

Regarding claims 56, 61, and 66, Jackson/Schloss discloses wherein the document managing part is further configured to manage correspondence between the document name of the second document data and the file names of the files from which the second document data is thus obtained (See col. 4, line 58-67 and col. 5, lines 41-55, Jackson et al.).

Regarding claims 57, 62 and 67, Jackson/Schloss discloses wherein the document name generating part is further configured to use indexes indicating an order in the second document data as the file names of the respective files from which the second document data is thus obtained (See col. 5, line 38 to col. 6, line 15, Jackson et al.).

Regarding claims 58, 63 and 68, Jackson/Schloss discloses wherein the document coupling control part is further configured to control, upon coupling document data together, an

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order of respective files from which the second document data is thus obtained (See col. 5, line 38 to col. 6, line 15, Jackson et al.).

Regarding claims 59, 64 and 69, Jackson/Schloss discloses a display control part configured to display a page through which an instruction by a user for coupling document data together is received (See Figs 2-6, Jackson et al.).

Conclusion

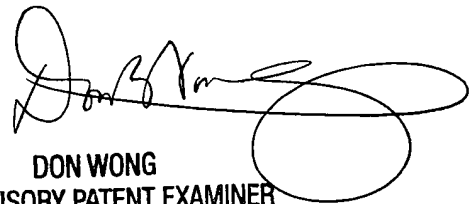
10. y inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MN
November 8, 2006



DON WONG
SUPERVISORY PATENT EXAMINER
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